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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/613,768

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Eric McKinlay

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EXAMINER

RUTTEN, JAMES D

ART UNIT

PAPER NUMBER

2192

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/613,768

Applicant(s)

MCKINLAY ET AL.

Examiner

J. Derek Rutten

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/20/03</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-20 have been examined.

#### *Priority*

2. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 10/056,956, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Independent claims 1, 9, and 15 contain limitations regarding the authorization of a download in the event that a browser does not alert a user prior to the download. While the '956 application discusses an alert related to authorization of a download (e.g. page 21 lines 11-16), there is no discussion regarding the event where the authorization alert does not occur. Claims 2-8, 10-14, and 16-20 are dependent upon these independent claims, and accordingly, claims 1-20 are not entitled to the benefit of the prior

application. It is noted that the general disclosure of the two applications appears to be nearly identical up until the enabling disclosure on pages 45-47 of the instant application.

### ***Drawings***

3. The drawings are objected to because they are not in compliance with 37 CFR 1.84(l). Figures 12, and 14-16 contain various grayscale images that would not provide satisfactory reproduction characteristics. Also, figures 12-14, and 16 contains text that is less than 1/8" in height which is not in compliance with 37 CFR 1.84(p)(3). It is noted that some of the text in figures 12, 14, and 16 is displayed in a representative browser window, and may not need to be comprehensible to convey the intended elements of the figures. However, any text that is directly related to the instant invention should be clearly legible. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and

informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 10 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 contains the trademark/trade name Verisign™. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe security certificates and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-3, 6-9, 11, 14-16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,366,912 to Wallent et al. (hereinafter "Wallent") in view of U.S. Patent 5,974,549 to Golan (hereinafter "Golan").

In regard to claim 1, Wallent discloses:

*A method of performing a software download over a computer network, the method comprising: detecting a setting of a browser; based on the setting of the browser, determining if the browser will alert a user before a software download; and..., not performing the download unless the user specifically authorizes the download. See*

Wallent column 4 lines 44-48:

Depending upon the security setting, the Web browser may perform the requested operation, prevent the requested operation from being performed, or **prompt the user** for a decision as to whether to perform the requested operation. (emphasis added)

Also see Fig. 4 with associated description at column 8 lines 45-50:

The security settings dialog window 402 includes an operation settings control 404, which provides a list of protected operations that can be configured by the mechanism of the invention.

This dialog window provides such operations as "Download signed ActiveX controls", which provides a setting to prompt the user before a download.

Wallent does not expressly disclose requiring authorization *if the browser will not alert the user*. However, in an analogous environment, Golan teaches that a secure

environment can be provided by monitoring a browser application and requiring authorization for continued execution. See column 7 lines 20-22:

If the security monitor DLL identifies such a security breach, it is operative to suspend execution and can **issue a warning** to the user describing the nature of the security breach. The user can then decide whether to terminate the downloadable software component or allow it to continue executing

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Golan's teaching of browser monitoring with Wallent's security zone. One of ordinary skill would have been motivated to alert a user to the presence of a potential security risk (Golan column 4 lines 58-61)

In regard to claim 2, the above rejection of claim 1 is incorporated. Wallent further discloses: *asking the user to specifically authorize the download; and performing the download if the user specifically authorizes the download*. See Fig. 5. Wallent does not expressly disclose: *displaying a non-browser message*. However, Golan teaches the display of a message by a security monitor. See column 2 lines 21-27.

In regard to claim 3, the above rejection of claim 2 is incorporated. Wallent further discloses: *wherein the ...message comprises a dialog box*. See Fig. 5. All further limitations have been addressed in the above rejection of claim 2.

In regard to claim 6, the above rejection of claim 1 is incorporated. Wallent further discloses: *wherein the download is not performed*. See Wallent column 4 lines 44-48.

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In regard to claim 7, the above rejection of claim 1 is incorporated. Wallent further discloses: *wherein the setting comprises a security setting*. See column 2 lines 57-60.

In regard to claim 8, the above rejection of claim 1 is incorporated. Wallent further discloses: *wherein detecting the setting comprises inspecting a registry of the browser*. See column 7 lines 23-25.

In regard to claim 9, Wallent discloses security settings and security messages. See column 4 lines 44-48 as cited in the above rejection of claim 1. All further limitations have been addressed in the above rejection of claims 1 and 2.

In regard to claims 11 and 14, the above rejection of claim 9 is incorporated. All further limitations have been addressed in the above rejection of claims 3 and 8, respectively.

In regard to claim 15, all limitations have been addressed in the above rejection of claim 1.

In regard to claims 16, 18-20 the above rejection of claim 15 is incorporated. All further limitations have been addressed in the above rejection of claims 7, 8, 2, and 3, respectively.

8. Claims 4, 5, 12, 13, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallent and Golan as applied to claims 2, 9, and 15 above, and further in view of U.S. Patent 6,061,733 to Bodin et al. (hereinafter "Bodin").



In regard to claim 4, the above rejection of claim 2 is incorporated. MC does not expressly disclose: *wherein the download involves providing a piece of software in chunks to a client computer*. However, in an analogous environment, Bodin teaches separating a large file into chunks for delivery to a client computer. See column 2 lines 62-64. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Bodin's teaching of chunks with MC's software download. One of ordinary skill would have been motivated to lower the probabilities that downloading a "large file will result a loss of connection, time-outs, or other system problems" (Bodin column 2 lines 56-59).

In regard to claim 5, the above rejection of claim 4 is incorporated. Wallent further discloses: *wherein the software download involves providing a piece of software in chunks to a client computer over an Internet*. See page column 6 lines 27-30.

In regard to claims 12 and 13, the above rejection of claim 9 is incorporated. All further limitations have been addressed in the above rejection of claims 4 and 5, respectively.

In regard to claim 17, the above rejection of claim 15 is incorporated. All further limitations have been addressed in the above rejection of claim 5.

9. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wallent and Golan as applied to claim 9 above, and further in view of U.S. Patent 6,629,081 to Cornelius et al. (hereinafter "Cornelius").

In regard to claim 10, the above rejection of claim 9 is incorporated. Wallent does not expressly disclose: *wherein the security message comprises a VeriSign™ prompt*. However, in an analogous environment, Cornelius teaches that VeriSign is used to check for signed certificates, and will display a dialog box in response to certain conditions related to such certificates. See column 216 lines 49-63. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Cornelius' teaching of Verisign certificates with Wallent's security model. One of ordinary skill would have been motivated to provide certified software to a consumer to promote quality and assign accountability.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Derek Rutten whose telephone number is (571) 272-3703. The examiner can normally be reached on T-F 6:00 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571) 272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jdr



TUAN DAM  
SUPERVISORY PATENT EXAMINER